

REMARKS

This is responsive to the Office Action mailed on June 14, 2005. In that Office Action, claims 1-8 were allowed and claims 9-21 were rejected. With this Amendment, claims 9,13,14,17 and 19 are amended and new claim 22 is added. The application includes claims 1-22.

The Office Action indicated that the Information Disclosure Statement filed on November 17, 2003 failed to comply with 37 C.F.R. § 1.98(e)(2) which requires a legible copy of each U.S. and foreign patent; each publication or that portion that caused it to be listed. Specifically, the information referred to under "Other Art" in the Information Disclosure Statement had not been considered.

With this Amendment, a new Information Disclosure Statement is being submitted with legible copies of all of the "Other Art". It is requested that the "Other Art" be considered.

The Office Action also objected to the drawings since reference element "73" which was mentioned in the description could not be found in the drawings.

Enclosed with this Amendment is a Replacement Sheet of Figure 2 with the reference element 73. It is requested that the objection to the drawings be withdrawn.

The Office Action then rejected claims 13, 14 and 19-21 under 35 U.S.C. § 101 alleging that they were drawn to non-statutory subject matter. Specifically, the Office Action stated "In claim 13 (line 3), claim 14 (line 2) and claim (line 7), applicant positively recites part of a human, i.e. "the knee joint" and "the knee"". Thus the claims include a human within their scope and are non-statutory.

Applicant respectfully disagrees. Claim 13 as amended further defines the retractor support as including "at least two arms, each arm being positionable along opposite sides of the knee joint." The knee joint is not positively recited as an element of the claimed structure. It is mentioned as part of the environment in which each arm extends. Claim 9 has been amended to help clarify this, defining in the preamble that the tibia and femur are part of the knee joint. Claim 14 has also been amended to state that the arms are "positionable" with respect to the knee joint. It is clear that the knee joint is not part of the claimed structure.

Similarly, claim 19 has been amended to state that the support arms "are extendable" along opposite sides of the knee. The knee is introduced in the preamble of the claim and it is not part of the apparatus. The knee is recited in the claim as part of the environment in which the support arms are extendable

If the Examiner believes that these amendments do not obviate the rejection under 35 U.S.C. § 101, applicant's attorney respectfully requests that the Examiner provide a suggestion as to how the knee or knee joint may be referred to in these claims and avoid positive recitation.

The Office Action then rejected claims 17-19 under 35 U.S.C. § 102(b) as being anticipated by Whitt U.S. Patent No. 4,373,709. The Office Action alleges that Whitt discloses a surgical limb holder that can be used to hold a limb in any position, the holder mounted to a surgical table having a support 11, arms 29 and a flexible strap 42 to restrain a lower portion of a leg or "lower leg" (col. 1, lines 19-21). The method steps of claims 17 and 18 were alleged to be inherently performed during use of the Whitt limb holder to restrain a limb during surgery.

In order for a claim to be anticipated by a reference, each and every element of the claim must be found in the reference. It is clear from the Whitt patent in Figure 1 that a lower leg portion is not being retained by the device as shown in Figure 1. What is being retained in the Whitt patent is the thigh. Although the phrase "the lower leg" is not specifically defined in the present application, it is understood that this is the portion of the anatomy that is below the knee joint. See Exhibits A, B and C attached to this Response which are copies of websites that describe the anatomy of the leg. The area above the knee is generally referred to as the thigh area. To ensure clarity in this application, the area below the knee has been referred to as "the lower leg". Therefore the phrase "lower leg" in the claims refers to that portion of the leg below the knee.

It would make no sense to use the structure disclosed in Whitt to support the lower leg. The joint (knee) could not be flexed and fully bent as necessary during the operating procedure discussed in Whitt (column 3, lines 17-22). The structure of Whitt has the "important advantage" of "arranging and holding the limb 35 over the edge (i.e. dangling over) of the

operating table 37. This permits the joint to be flexed and fully bent as necessary during the operating procedures" *Id.* If the lower leg was secured in the structure of Whitt, it could not be bent. Therefore, claim 17 cannot be anticipated by the Whitt patent. In addition, the steps of claims 17 and 18 are also not anticipated by the Whitt patent for the same reasons. Applicant has also added new claim 22 which depends from claim 17. For the same reasons as claims 17 and 18, new claim 22 is also not anticipated.

Next, the Office Action rejected claims 17 and 18 under 35 U.S.C. § 103 for the same reasons as discussed with respect to the anticipation by the Whitt patent. For the same reasons as discussed above, there is no suggestion, teaching or motivation to place the structure of Whitt on the lower leg. The purpose of the Whitt structure could not be achieved as discussed above.


Therefore, in view of the above, it is respectfully requested that the rejection under 35 U.S.C. § 103 also be withdrawn with respect to claims 17 and 18 and the claims allowed.

In view of the above, it is requested that all of the claims in the present application be reconsidered and a Notice of Allowance be issued thereon.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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